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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/628,538

07/28/2003

David A. Martin

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EXAMINER

RAJ, RAJIV J

ART UNIT

PAPER NUMBER

4143

NOTIFICATION DATE

DELIVERY MODE

05/02/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

iplaw@brouse.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/628,538	<b>Applicant(s)</b> MARTIN ET AL.	
	<b>Examiner</b> RAJIV J. RAJ	<b>Art Unit</b> 4143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23 and 35-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>17 October 2005 &amp; 20 September 2007</u> .                 | 6) <input type="checkbox"/> Other: _____                          |



## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the application filed on 28 July 2003.
2. Claims 23, 36, and 37-39 have been amended.
3. Claims 1-22 and 24-34 have been canceled.
4. Claims 23 and 35-39 are currently pending and have been examined.

### **Information Disclosure Statement**

5. The Information Disclosure Statements filed on 17 October 2005 and 20 September 2007 have been considered. Initialed copies of the Form 1449 are enclosed herewith.

### **Priority**

6. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

### **Double Patenting**

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 23 and 35-39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6862571 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because both disclose a process and an apparatus for linking medical malpractice insurance policies with a credentialing questionnaire. The patent does not specifically disclose the *providing at least one blank space on the questionnaire or a means for providing at least one blank space on the questionnaire*; however it would have been obvious to one skilled in the art at the time of the invention that *providing at least one blank space on the questionnaire* would be an obvious modification because this is a necessary component of filling out the "questionnaires" disclosed in the patent.

### Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under

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the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 23 and 35-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Martin et al. (US 6862571), hereinafter Martin.

11. The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

**Claim 23**

Martin, as shown, discloses the following limitations:

- *transferring information from the medical malpractice insurance policy to the credentialing questionnaire* (see at least Martin claim 1 limitation 11: "electronically transferring the credentialing information from the medical malpractice insurance policy to the subsequent credentialing application")
- *forwarding the credentialing questionnaire to an associated healthcare provider for review and approval* (see at least Martin claim 1 limitation 9: "delivering the medical malpractice insurance application to the physician for the physician's review and approval")

**Claim 35**

Martin, as shown, discloses the following limitations:

- *requesting information from the healthcare provider to fill in the at least one blank space* (see at Martin claim 7 limitation 1: "inserting means for obtaining the healthcare providers permission for release of the credentialing information to a medical malpractice insurance provider into the questionnaire,")

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**Claim 36**

Martin, as shown, discloses the following limitations:

- *forwarding the completed questionnaire to an associated credentialing entity (see at least Martin claim 1 limitation 2: “electronically forwarding the information to an associated credentialing entity”)*

**Claim 37**

Martin, as shown, discloses the following limitations:

- *means for transferring information from the medical malpractice insurance policy to the credentialing questionnaire (see at least Martin claim 1 limitation 11: “electronically transferring the credentialing information from the medical malpractice insurance policy to the subsequent credentialing application”)*
- *means for forwarding the credentialing questionnaire to an associated healthcare provider for review and approval (see at least Martin claim 1 limitation 9: “delivering the medical malpractice insurance application to the physician for the physician's review and approval”)*

**Claim 38**

Martin, as shown, discloses the following limitations:

- *means for requesting information from the healthcare provider to fill in the at least one blank space (see at Martin claim 7 limitation 1: “inserting means for obtaining the healthcare providers permission for release of the credentialing information to a medical malpractice insurance provider into the questionnaire,”)*

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**Claim 39**

Martin, as shown, discloses the following limitations:

- *means for forwarding the completed questionnaire to an associated credentialing entity* (see at least Martin claim 1 limitation 2: "electronically forwarding the information to an associated credentialing entity")

**Claim Rejections - 35 USC § 103**

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 23 and 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman et al. (US 6035276) (hereinafter Newman).

**Claim 23**

**Newman as shown, discloses the following limitations:**

- *transferring information from the medical malpractice insurance policy to the credentialing questionnaire*; (see at least Newman Column:6 Lines:66-67 Column:7 Lines:1-5 "As represented by reference numeral 36, the selected provider application format is conventionally extracted from the provider application database and populated or completed with information from the



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selected physician credentialing profile to generate the particular provider application form which has been selected in the format associated with that form.”)

- *forwarding the credentialing questionnaire to an associated healthcare provider for review and approval.* (see at least Newman Column:5 Lines:10-16 “The completed provider application form may then be printed on a conventional printer, such as an HP LASER JET, and delivered to the physician, (or transferred electronically to the physician for printing on a conventional printer within the physician's office), reviewed, signed, and submitted to the appropriate health care provider organization.”)

Johnson does not specifically disclose *malpractice insurance policy*. However, it would have been obvious to one skilled in the art at the time of the invention to modify the “the provider application database” of Johnson to show the *malpractice insurance policy* because it is an obvious component of “the provider application database”.

**Claim 35****Johnson as shown, discloses the following limitations:**

- *providing at least one blank space on the questionnaire where information from the insurance policy does not match with at least one question on the questionnaire;* (see at least Newman Column:5 Lines:10-16 “Each blank on the application is then evaluated for a matching data base field 56. A determination is then made as to whether or not there is a matching field in the data base 58. If not then it is left blank 60.”)
- *requesting information from the healthcare provider to fill in the at least one blank space* (see at least Newman Column: 3 Lines:64-67 Column:4 Lines:1-15 “collecting physician credentialing information, creating electronic versions of provider application formats, completing selected provider application formats with selected physician credentialing information and generating a preferred

provider application form in the associated format for use by the physician. Of course, portions (or all) of these steps may be accomplished by the physician or an independent physician association to which the physician belongs. (4) In another embodiment, a blank universal application form is stored on a conventional computer disk (or similar media) and the disk is sent to the physician. The physician, using a conventionally programmed digital computer, programmed with the software of the present invention, completes the universal application form and returns the disk (or its contents) to the credentialing managing organization. The physician may transmit the disk (or its contents) to the credentialing managing organization by any means including, for example, electronic mail, modem, or conventional mail services.”)

**Claim 36****Johnson as shown, discloses the following limitations:**

- *forwarding the completed questionnaire to an associated credentialing entity* (see at least Newman Column:3 Lines:45-56 “the physician (or his or her staff) may manually complete a pre-printed universal application form. The form is then delivered to a credentialing managing organization,”)

**Claim 37****Newman as shown, discloses the following limitations:**

- *means for transferring information from the medical malpractice insurance policy to the credentialing questionnaire;* (see at least Newman Column:6 Lines:66-67 Column:7 Lines:1-5)
- *means for forwarding the credentialing questionnaire to an associated healthcare provider for review and approval.* (see at least Newman Column:5 Lines:10-16)

Johnson does not specifically disclose *malpractice insurance policy*. However, it would have been obvious to one skilled in the art at the time of the invention to modify the “the

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provider application database” of Johnson to show the *malpractice insurance policy* because it is an obvious component of “the provider application database”.

**Claim 38**

**Johnson as shown, discloses the following limitations:**

- *means for providing at least one blank space on the questionnaire where information from the insurance policy does not match with at least one question on the questionnaire; (see at least Newman Column:5 Lines:10-16)*
- *means for requesting information from the healthcare provider to fill in the at least one blank space (see at least Newman Column: 3 Lines:64-67 Column:4 Lines:1-15)*

**Claim 39**

**Johnson as shown, discloses the following limitations:**

- *means for forwarding the completed questionnaire to an associated credentialing entity (see at least Newman Column:3 Lines:45-56)*

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### **Conclusion**

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Rajiv J. Raj** whose telephone number is **571-270-3930**. The Examiner can normally be reached on Monday-Friday, 7:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A. Reagan** can be reached at **571.272.6710**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to **571-273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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Date: 04/25/08

/Rajiv J Raj/ Patent Examiner Art Unit 4143

/James A. Reagan/

Supervisory Patent Examiner, Art Unit 4143